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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,509	10/30/2003	John J. Gregel	ERICP0326USB	7672
7590	09/29/2005		EXAMINER	
Jonathan A. Platt Renner, Otto, Boisselle & Sklar, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			BRITtain, JAMES R	
			ART UNIT	PAPER NUMBER
			3677	
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/697,509	GREGEL ET AL.
	Examiner James R. Brittain	Art Unit 3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 6,9-17,19-25 and 40-55 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,7,8,18 and 26-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02052004,02222005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### *Election/Restriction*

Applicant's election without traverse of Invention I, Group 5 in Paper No. 07112005 is acknowledged.

Claims 6, 9-17 and 19-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 07112005.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7, 18 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6719478. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art that the circumferential projection on one jaw element fitting in a corresponding recess in an adjacent jaw element to hold the jaw elements axially aligned as found in claim 1 of the patent comprises structure that physically couples the jaw elements together thereby rendering obvious the subject

matter of claim 1 of this application. Similarly, each of the other generic claims listed above defines structure obvious over claim 1 and the other cited species specific claims in the parent patent.

### ***Claim Objections***

Claim 26 is objected to because of the following informalities: The term “with” (line 4) is misspelled. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7, 8, 18 and 26-39 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation “the jaw element sections” (claim 1, lines 5-6) is plural, but the two preceding usages on lines 2 and 3 are singular. It is not clear if applicant is claiming one or a plurality of “jaw element sections”. The claim is being interpreted as only requiring one jaw element section. This interpretation is being reinforced by the scope of claim 18 that calls for “at least two jaw element sections”. The remaining claims are indefinite because they depend from an indefinite claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 39 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Wu (US 5193932).

Wu (figures 1-3) teaches a reinforcing bar splice comprising: a jaw element section 10 configured to engage ends of generally axially aligned reinforcing bars 30, wherein the jaw element section includes multiple jaw elements defined by the tapered elements created by the sleeve 12 divided by the axially oriented slits 13 that are physically coupled together via the remaining central structure of the jaw element section 10; and tapered collars 20 for engaging tapered outer surfaces of the jaw element section to force the jaw elements together to grip the ends of the reinforcing bars. As to claim 2, the jaw element section allows the reinforcing bars to be fully inserted and therefore meet the claim language. In regard to claim 3, the tapered collars axially engage the jaw element section. As to claims 4 and 5, the jaw elements have substantially circumferentially extending teeth defined by the slits 13 dividing the sleeve 12.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 8, 18, 26-29, 31-36 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cherry et al. (US 4508409) in view of Werner (US 4408926).

Cherry et al. (figures 1-7) teaches two species of wire holding clamps. In regard to the first species of figures 1-4, Cherry et al. teaches wire holding clamp comprising a jaw element

section 14, 16 configured to engage ends of generally axially aligned wires, wherein the jaw element section includes multiple jaw elements 14 physically coupled together by retaining ring 16 and there are tapered collars 18 for engaging tapered outer surfaces of the jaw element section 14, 16 to force the jaw elements 14 inward to grip ends of the wire. Further, applicant's claim construction is so broad as to permit an alternative reading of the first species of figures 1-4, wherein Cherry et al. teaches wire holding clamp comprising a plurality of jaw element sections 14 configured to engage ends of generally axially aligned wires, wherein each jaw element section includes multiple jaw elements in the form of the teeth 56 wherein the jaw element are physically coupled together by the remaining teeth connecting portion of the jaw element sections 14 and there are tapered collars 18 for engaging tapered outer surfaces of the jaw element sections 14 to force the jaw element sections 14 inward to grip ends of the wire. In regard to the second species of figures 5-7, Cherry et al. teaches wire holding clamp comprising a plurality of jaw element sections 14 configured to engage ends of generally axially aligned wires, wherein each jaw element section includes multiple jaw elements 70 physically coupled together by retaining ring 16 and there are tapered collars 18 for engaging tapered outer surfaces of the jaw element sections 14 to force the jaw element sections 14 inward to grip ends of the wire. The difference for both species is that the devices grip wire and is not disclosed as a reinforcing bar splice. It would have been obvious to use the devices of Cherry et al. as reinforcing bar splices in view of Werner (figures 1-5) teaching that wire holding clamps have characteristics whereby they can be used as reinforcing bar clamps as indicated in col. 3, lines 1-5. In regard to claims 5 and 8, Cherry et al. shows symmetric teeth and Werner teaches the desirability of using circumferentially oriented symmetric teeth in the figures as such a

configuration is well known thereby rendering obvious the use of circumferentially oriented symmetric teeth. As to claims 26-29, the second species of Cherry et al. shows in figures 5-7 the use of a tapered shell 14 and jaw elements 70 fitting into corresponding recesses of the tapered shell that can grip. In regard to claim 31, Cherry et al. shows that the collars are made of two different materials with the outer one being non-conductive. In regard to claims 32-36, carbon fibers are non-conductive materials and their use would have been obvious as a matter of choosing a material known for its non-conductive and strong material properties.

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cherry et al. (US 4508409) in view of Werner (US 4408926) as applied to claim 1 above, and further in view of Clark (US 1337642).

Further modification of the wire holder of Cherry et al. so that the jaw element section is fully radially external to the reinforcing bars would have been obvious in view of Clark (figure 2) teaching such structure to be well known for securing cylindrical bars together as it provides a more compact structure while still physically coupling the jaws together via a circumferential projection on one jaw element fitting in a corresponding recess in an adjacent jaw element to hold the jaw elements axially aligned (page 1, lines 92-100).

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cherry et al. (US 4508409) in view of Werner (US 4408926) as applied to claim 4 above, and further in view of Davis (US 2652273).

Further modification of the wire holder of Cherry et al. that is usable to hold reinforced bar as taught by Werner so that the teeth are asymmetric would have been obvious in view of

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Davis (figure 4) that teaches the use of asymmetric teeth 38 as being desirable to hold cable and is applicable to holding reinforcing bar through the teachings of Werner.

Claim 30 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cherry et al. (US 4508409) in view of Werner (US 4408926) as applied to claim 26 above, and further in view of Trovillion (US 373789).

Further modification of the wire holder of Cherry et al. so that the jaw elements have a parallelepiped shape would have been obvious in view of Trovillion (figures 1-4) teaching a rectangular shape for the jaw element K and that it is desirable to facilitate replacement when worn (page 1, lines 63-75) and while not all faces are parallel it suggests a linear configuration so as to be replaceable, a desirable result rendering obvious applicant's shape.

Claims 37 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cherry et al. (US 4508409) in view of Werner (US 4408926) as applied to claim 1 above, and further in view of Jartoux (US 4941303).

Further modification of the wire holder of Cherry et al. so that there is lubricant between the shells and the collars would have been obvious in view of Jartoux (figure 1) suggesting the use of a lubricant between the wedges and the housing in order to reduce friction (col. 3, lines 6-12) the common use of lubricant, a beneficial result. As to claim 38, the use of a synthetic polymer lubricant would be a common choice readily available and is the particular choice of a material for the desired result and would have been obvious.

Claims 7 and 8 rejected under 35 U.S.C. §103(a) as being unpatentable over Wu (US 5193932).

Wu (figures 1-3) teaches a reinforcing bar splice comprising: a jaw element section 10 configured to engage ends of generally axially aligned reinforcing bars 30, wherein the jaw element section includes multiple jaw elements defined by the tapered elements created by the sleeve 12 divided by the axially oriented slits 13 that are physically coupled together via the remaining central structure of the jaw element section 10; and tapered collars 20 for engaging tapered outer surfaces of the jaw element section to force the jaw elements together to grip the ends of the reinforcing bars. The jaw elements have substantially circumferentially extending teeth defined by the slits 13 dividing the sleeve 12. The difference is that the teeth are not shown in the figures as being symmetric or asymmetric. However, the teeth are formed as internal threads divided by slits 13 and applicant is given Official Notice that the use of symmetric or asymmetric threads is old and well known for provided threads and it there use would have been obvious.

Claims 37 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wu (US 5193932).

Wu (figures 1-3) teaches a reinforcing bar splice comprising: a jaw element section 10 configured to engage ends of generally axially aligned reinforcing bars 30, wherein the jaw element section includes multiple jaw elements defined by the tapered elements created by the sleeve 12 divided by the axially oriented slits 13 that are physically coupled together via the remaining central structure of the jaw element section 10; and tapered collars 20 for engaging tapered outer surfaces of the jaw element section to force the jaw elements together to grip the ends of the reinforcing bars. The difference is that lubricant is not used between the jaw element section and collars. However, Jartoux (figures 1) teaches the use of lubricant between the

wedges and housing. It would have been obvious to modify the reinforcing bar splice of Wu to utilize lubricant in view of Jartoux (figure 1) suggesting the use of a lubricant between the wedges and the housing in order to reduce friction (col. 3, lines 6-12) the common use of lubricant, a beneficial result. As to claim 38, the use of a synthetic polymer lubricant would be a common choice readily available and is the particular choice of a material for the desired result and would have been obvious.

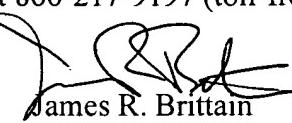
***Conclusion***

The patents of Howlett (US 4239246, figure 2), Gregel (EP 12225284, figures 1-10), West (US 2441304, figures 1-4), Filhaber (US 3852850, figures 6, 7), Lienhart (US 4872626, figures 1-4), Biass (US 5022125, figures 1, 2), Trautmann (DE 1659247, figures 2-4), Cho (WO 00/66852, figures 1-3), Jansen (US 3117485, figures 1, 2, 5), Bowden (US 391226, figure 5), Nestor (US 3614140, figures 1-4) and Garver et al. (US 5683273, figures 1-4) teach pertinent clamp structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain  
Primary Examiner  
Art Unit 3677

JRB